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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/966,824      | 09/27/2001  | Michael Darryl Ruehle | 2207/ 11838         | 5014             |

7590 01/16/2004  
 KENYON & KENYON  
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EXAMINER

HUYNH, KIM NGOC

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2182

DATE MAILED: 01/16/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/966,824

Applicant(s)

RUEHLE ET AL.

Examiner

Kim Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) ✓
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-8, 15-20 and 28-30 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6, 14-19 and 27-30 of copending Application No. 09/967,539. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. Though the claims states that there are 'N' or less non-relevant data values (memory addresses) between the first and the last relevant values (memory addresses) versus two sequential relevant values (memory addresses). Please note a sequence of two relevant values, the first and the last values are sequential.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In*

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*re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 9-10 and 21-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-8 and 20-21 of U.S. Patent No. 09/967,539. Although the conflicting claims are not identical, they are not patentably distinct from each other because the counter of N+2 stage is a relative value which does not distinguish from the counter of the copending application.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for perceiving an event triggering command as disclosed, does not reasonably provide enablement for the claim limitations as in claims 1-30.

Claims 1 and 15 recite a command is perceived upon a detection of a predetermined sequence of relevant data values within a string of data values if the string of data values includes 'N' or less non-relevant data values between any two

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sequential data values in the string of data value. Claim 28 recites a command is perceived upon a detection of a predetermined sequence of relevant memory locations within a string of memory locations if the string of memory locations includes 'N' or less non-relevant memory locations between any two sequential relevant memory locations in the string of memory locations.

The logic (first) device to perceive the command does not appear in combination with another recited element/step in order to perform the detecting operation of a predetermined sequence and therefore covers every conceivable means for to achieve the stated purpose of detecting a predetermined sequence. Furthermore, the value 'N' is undefined which renders the device inoperable since command would never be perceived by the system if N is a infinite number as related to the maximum count of the counter. The specification disclosed at most only those means/step known to the inventor with specific elements/operations of the sequence detector and a defined value 'N'.

The claims as recited would cover every data string having a command code embedded within it; therefore the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 14, and 28 recite 'N' or less non-relevant data values (memory locations) between a first and last relevant data values (memory location). It is unclear what applicant defines a 'N' and how this 'N' value relates to the total number of values (memory location) in the string and the total number of relevant values (memory locations) 'K' in the sequence.

As for claims 1-27, claims 3-4 and 17-18 refer to a first and third device, however, none of claims 1-26 mention any information regarding a second device. This renders the claims vague since it is unclear if a second device is intended in the system.

9. Although the specification provides a dictionary for the claims, and the claims may be broader than the claims, the claims must be complete and self-consistent so that the functional relationships between all of the elements/steps are clearly recited. The sequential logical operation of the elements working cooperatively must be clearly recited in the claims.

No art rejections are made because the specification does not provide adequate description of the invention to enable the examiner to interpret the claims based on specification in light of the 35 USC 112 rejections without requiring the examiner to make a great deal of speculative assumptions. See MPEP 2173.06 wherein it is stated:

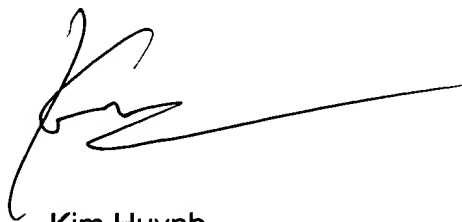
"... where there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of a claim, it would not be proper to reject such a claim on the basis of prior art. As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection under 35 U.S.C. 103 should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims."

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Maxwell et al. (US 4,060,797), Kato et al. (US 5,408,678), Loomis et al. (US 6,092,193), Erbes et al. (US 5,249,232), Lee et al. (US 5,377,264), Markwitz et al. (US 4,627,074), Ryan (US 6,522,694), Patel et al. (US 5,491,698), Sawaguchi et al. (US 5,392,316), Adlhock (US 3,629,847), and Candelore et al. (US 6,061,449).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Huynh whose telephone number is (703) 308-1678.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to be 'Kim Huynh', with a long horizontal line extending to the right.

Kim Huynh  
Primary Examiner  
Art Unit 2182

KH  
January 9, 2004